

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENERAL PLASTIC INDUSTRIAL CO., LTD.,
Petitioner,

v.

CANON KABUSHIKI KAISHA,
Patent Owner.

Case IPR2016-01361
Patent 8,909,094 B2

Before JAMESON LEE, THOMAS L. GIANNETTI, and
SHEILA F. McSHANE, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
35 U.S.C. § 314(a); 37 C.F.R. §§ 42.108

I. INTRODUCTION

A. *Background*

On July 8, 2016, a Petition (Paper 2, “Pet.”) was filed to institute *inter partes* review of claims 1, 7–9, 11, 16–18, 29, and 38 of U.S. Patent No. 8,909,094 B2 (Ex. 1001, “the ’094 patent”). Patent Owner filed a Preliminary Response (Paper 5, “Prelim. Resp.”) on August 29, 2016. We authorized Petitioner to file a Reply and Patent Owner to file a Sur-Reply. Paper 7. Petitioner filed a Reply (“Reply”). Paper 8. Patent Owner filed a Sur-Reply (“Sur-Reply”). Paper 10.

For the reasons that follow, we exercise our discretion to deny the Petition and *not* institute *inter partes* review of claims 1, 7–9, 11, 16–18, 29, and 38 of the ’094 patent.

B. *Related Matters*

The parties indicate that the ’094 patent was the subject of an investigation (now terminated) before the International Trade Commission: *In the Matter of Certain Toner Supply Containers And Components Thereof*, Inv. No. 337-TA-960. Pet. 2; Paper 4, 2.

Petitioner has, thus far, filed four separate petitions for *inter partes* review of the ’094 patent. The first, IPR2015-01954, was filed on September 25, 2015. Pet. 2. This petition challenged claims 1, 7–9, 11, 16–18, 29, and 38 (the same claims challenged here) of the ’094 patent. IPR2015-01954 Paper 2, 1. After reviewing the petition in that proceeding, the Board declined, on March 9, 2016, to institute *inter partes* review of any challenged claim of the ’094 patent. IPR2015-01954 Paper 9, 27.

Concurrently with the filing of this Petition, on July 8, 2016, Petitioner filed

two additional petitions for *inter partes* review of the '094 patent. Those petitions are now pending in IPR2016-01359 and IPR2016-01360.

For the purposes of this Decision, we adopt Petitioner's nomenclature for the various petitions it has filed challenging claims of the '094 patent. Thus, Petitioner identifies the petition here as "Fourth Petition," the petition in IPR2016-01359 as "Second Petition," and the petition in IPR2016-01360 as "Third Petition," all relative to the petition filed in IPR2015-01954, which we will refer to as "First Petition."

C. The '094 Patent

Of all challenged claims, claims 1, 11, 29, and 38 are independent and all are directed to a "toner supply container."

D. Evidence Relied Upon

Reference		Date	Exhibit
Yasuda	U.S. Pat. No. 5,481,344	Jan. 2, 1996	Ex. 1006

Petitioner also relies on the Declaration of Brian Springett, Ph.D. Ex. 1007. In addition, with its Reply, Petitioner provided a Declaration of Hui-Wen Hsieh. Ex. 1008.

E. The Asserted Ground of Unpatentability

Petitioner challenges claims 1, 7–9, 11, 16–18, 29, and 38 on one ground: obviousness under 35 U.S.C. § 103 over Yasuda. Pet. 20.

II. ANALYSIS

A. *Discretionary Non-Institution*

1. Overview

Institution of *inter partes* review is discretionary. *See* 35 U.S.C. § 314(a); 37 C.F.R. § 42.108(a). A number of factors are considered in deciding whether to exercise discretion not to institute review, including:

- (a) the finite resources of the Board;
- (b) the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review;
- (c) whether the same petitioner previously filed a petition directed to the same claims of the same patent;
- (d) whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;¹
- (e) whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition;²
- (f) the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition; and

¹ *See Conopco, Inc. v. Proctor & Gamble Co.*, Case IPR2014-00506, slip op. at 4 (PTAB Dec. 10, 2014) (Paper 25) (Informative), and slip op. at 6 (PTAB July 7, 2014) (Paper 17); *Toyota Motor Corp. v. Cellport Sys., Inc.*, Case IPR2015-01423, slip op. at 8 (PTAB Oct. 28, 2015) (Paper 7).

² *See Conopco, Inc. v. Proctor & Gamble Co.*, Case IPR2014-00628, slip op. at 11 (PTAB October 20, 2014) (Paper 21) (discouraging filing of a first petition that holds back prior art for use in later attacks against the same patent if the first petition is denied); *Toyota Motor Corp.*, slip op. at 8 (“the opportunity to read Patent Owner’s Preliminary Response in IPR2015-

- (g) whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent.

LG Electronics Inc. v. Core Wireless Licensing S.A.R.L., Case IPR2016-00986 (PTAB Aug. 22, 2016) (Paper 12) slip op. at 6–7; *NVIDIA Corp. v. Samsung Elecs. Co.*, Case IPR2016-00134 (PTAB May 4, 2016) (Paper 9) slip op. at 6–7 (“*Nvidia*”).

2. The First Petition—Filed in IPR2015-01954

As noted above, the Petition here is not the first petition filed by Petitioner challenging claims 1, 7–9, 11, 16–18, 29, and 38 of the ’094 patent. The First Petition was filed on September 25, 2015, in IPR2015-01954, alleging two grounds of unpatentability:

(1) that claims 1, 8–9, 11, 17–18, 29, and 38 are anticipated by Matsuoka (U.S. Patent No. 5,903,806) under 35 U.S.C. § 102(b); and

(2) that claims 1, 7–9, 11, 16–18, 29, and 38 are unpatentable as obvious over Matsuoka under 35 U.S.C. § 103.

3. The Decision Denying Institution in IPR2015-01954

The First Petition (in IPR2015-01954) was denied on March 9, 2016. Ex. 3001.³ More than nine months passed between Petitioner’s filing of the First Petition, on September 25, 2015, and Petitioner’s filing of the Fourth Petition, in this proceeding, on July 8, 2016. During that time, Patent Owner filed a preliminary response in IPR2015-01954, addressing, *inter alia*, why

00634, prior to filing the Petition here, is unjust.”).

³ *General Plastic Industrial Co., LTD v. Canon Inc.*, Case IPR2015-01954, (PTAB March 9, 2016) (Paper 9).

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